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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,437	12/28/2001	Keith A. Riha	TRM TR000024 DIV	9561
7590	01/23/2004			
Steven J. Grossman GROSSMAN, TUCKER, PERREAULT & PFLEGER, PLLC 55 South Commercial Street Manchester, NH 03101			EXAMINER STAICOVICI, STEFAN	
			ART UNIT 1732	PAPER NUMBER

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/033,437

Applicant(s)

RIHA ET AL.

Examiner

Stefan Staicovici

Art Unit

1732

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 1.Claim(s) withdrawn from consideration: None.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See attachment

ATTACHMENT TO ADVISORY ACTION

Response to Amendment

1. Applicant's After-Final response filed January 2, 2004 will be entered. Claim 1 is pending in the instant application.

Response to Remarks

2. Applicants' arguments filed January 2, 2004 have been considered.

Applicants argue that in the Office Action mailed September 30, 2003 the Examiner's argument stating "Applicant could not attack the references individually, where the rejection was based upon a combination" is not fully understood. In order to provide a clear record, Applicants' attention is drawn to the fact that the arguments presented by Applicant in the amendment filed July 7, 2003 were drawn to newly presented claim limitations not previously presented.

Applicants argue "Filion '630 and/or Filion '028 do not teach or suggest anything regarding the advantages, desirability, convenience or even hint at the opportunity to successfully project a laser beam to an outer skin surface in an area that overlies a switch," whereas "Spanjer '290 does not teach or suggest the use of a skin separately formed by casting, spray coating, blow molding or thermoforming, having a color, and that such skin can be effectively discolored by a laser, over a switch, embedded in a foam" (see pages 4-5 of the After-Final response filed January 2, 2004). In response, it should be noted that, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re*

Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Specifically, under MPEP §2141.02 it is noted that “[I]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the *claimed invention as a whole* would have been obvious” (emphasis added). Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Further, MPEP §2141.02 states that a “prior art reference must be considered in its *entirety, i.e., as a whole*, including portions that would lead away from the claimed invention” (emphasis added). W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). As such, it is submitted that:

(a) the main reference of Filion *et al.* ('630), teach, providing an outer skin (26b') formed by vacuum forming (thermoforming), a foam layer (26b'') bonded to said skin, a substrate layer (22b) bonded to said foam layer (26b'') and a at least one switch (30b) embedded in said foam layer (26b'') (see Figure 5 and, col. 3, lines 60-64; col. 5, lines 31-34 and lines 54-61). Further, Filion *et al.* ('630) teach marking of said outer skin layer (see Figure 1);

(b) the secondary reference of Filion *et al.* ('028) teach a *printing process* (emphasis added) for forming indicia (30) on a laminate including an outer skin (28), a foam layer (26) bonded to said skin, a substrate layer (24) bonded to said foam layer (26) and at least one switch (20) embedded in said foam layer (26), said indicia overlying said

embedded at least one switch (20) (see col. 2, line 67 through col. 3, line 23; col. 3, lines 37-61; col. 5, lines 29-43 and Figure 6);

(c) the secondary reference of Spanjer ('290) teaches that a polymeric material that includes a pigment die changes color upon interaction between said pigment die and a laser beam and forms a marking of a different color than the surrounding material (see col. 1, lines 52-60). Further, Spanjer ('290) teaches laser marking as a replacement for printing, hence teaching *laser marking as an equivalent alternative* (emphasis added) to printing (see col. 1, lines 24-25).

Therefore, it would have been obvious for one of ordinary skill to have provided a colored outer skin and have used a laser marking method as taught by Spanjer ('290) as an alternative to the printing process of Filion *et al.* ('028) to form indicia in the process of Filion *et al.* ('630) because, Filion *et al.* ('630) teaches marking of said outer skin layer and Spanjer ('290) teaches that laser marking and printing are equivalent alternatives and also because, laser marking provides a clearer and more durable marking, while eliminating the extra processing step in the printing process of applying a clear coat over a printed mark.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (571) 272-1208. The examiner can normally be reached on Monday-Friday 9:30 AM to 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianni, can be reached at (571) 272-1196.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1300.

Stefan Staicovici, PhD



Primary Examiner

1/20/04

AU 1732

January 20, 2004